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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,744

09/12/2003

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EXAMINER

MARCUS, LELAND R

ART UNIT

PAPER NUMBER

3694

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/660,744	Applicant(s) NOZAKI ET AL.	
	Examiner Leland Marcus	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/12/03, 4/27/04, 12/11/07, 5/13/08, 9/29/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

35 U.S.C. 112, 1st paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification appears to be a literal translation into English from a foreign document and, as such, is replete with grammatical and idiomatic errors is replete with terms which are not clear, concise, and exact. The specification should be idiomatically translated into English.

Claim Objections

The claims section is objected to because the claims are generally indefinite and fail to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The claims should be idiomatically translated into English. For purposes of examination, the Examiner will review claims that appear to be similar as a group.

Claims 4-41 are objected to because the claim numbering is improper. A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. See MPEP § 608.01(n). In general, however, applicant's sequence will not be changed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2-44 (even numbers only) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1 and 2-40 (even numbers only), the claims do not contain sufficient physical embodiment to qualify as a machine or manufacture. By way of example, incorporation of the “communication terminal” of claim 3 is sufficient physical embodiment to overcome this rejection.

As to claims 42 and 44, the method claims are not tied to another statutory class and do not transform underlying subject matter (such as an article or material) to a different state or thing. As such, these methods are not patent eligible processes. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) and *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 14-15, 18-21, 24-27, and 36-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa, US 6,853,977 (previously published as JP 2001-160108).

As to claims 1-7, 14-15, 18-21, 24-27, and 42-47, Niwa teaches a settlement terminal, a payment terminal (mobile terminal), and a settlement center are electronically connected.

When a buyer purchases an item, transactional data is sent for settlement. The transactional data is sent from the settlement terminal to the payment terminal; a terminal identifier is sent from the payment terminal to the settlement terminal; the business identifier, monetary data, terminal identifier and processing identifier are sent from the settlement terminal to the settlement center; the business identifier, the monetary data, the terminal identifier, the processing identifier and a password are sent from the settlement terminal to the settlement center.

Depending on whether the two sets of data are identical, certification is provided by the settlement center. If the data are confirmed to be identical, whether the password received and a password registered are identical or not is checked; if certification is provided, the settlement process is executed; and completion of the settlement is communicated to the settlement terminal and the payment terminal by the settlement center.

As to claims 36-41, Niwa teaches a settlement terminal, the payment terminal (mobile terminal), and the settlement center are connected electronically, and the settlement terminal and the payment terminal are electronically connected by an infrared wireless transmission line.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-13, 16-17, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa in view of Nishimura, JP 2002-007698.

As to claims 8-11, Niwa does not teach a mobile telephone number (customer identification information) is sent from a mobile terminal to a shop terminal. However, Nishimura does teach a mobile telephone number (customer identification information) is sent from a mobile terminal to a shop terminal and a management device provides certification by confirming whether the customer identification information received from the shop terminal is stored in the storage.

It would be obvious to one skilled in the art at the time of the invention to combine the settlement system of Niwa with the use of telephone numbers of Nishimura. The rationale is that the claimed invention is simply a combination of old elements, and in the combination each element performs the same function as it does separately, and the results of the combination are predictable (rationale A of the *KSR* decision).

As to claims 12-13, Niwa teaches that the payment terminal sends terminal identifier to the settlement terminal when the inputted password is identical to the password stored in the storage.

As to claims 16-17 and 22-23, the art and rationale of claims 8-11 rejections apply.

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa in view of Miura, JP 2001-249969.

As to claims 28 and 29, Niwa does not specifically teach confirmation messages. However, Miura does teach message asking for confirmation of the purchased items are communicated to a mobile terminal of a customer before payment process. It would be obvious to one skilled in the art at the time of the invention to combine the settlement system of Niwa with the confirmation of Miura. The rationale is that the claimed invention is simply a combination of old elements, and in the combination each element performs the same function as it does separately, and the results of the combination are predictable (rationale A of the *KSR* decision).

Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa in view of Hishinuma et al., JP 2002-092323.

As to claims 30-33, Niwa does not specifically teach duplicate payments. However, Hishinuma does teach duplicate payment is prevented by setting a payment completion flag that shows whether payment is done or not for each of billing information. It would be obvious to one skilled in the art at the time of the invention to combine the settlement system of Niwa with the duplicate payments of Hishinuma. The rationale is that the claimed invention is simply a combination of old elements, and in

the combination each element performs the same function as it does separately, and the results of the combination are predictable (rationale A of the *KSR* decision).

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa in view of Toyoda, JP 2002-032686.

As to claims 34 and 35, Niwa does not teach specifically teach item descriptions. However, Toyoda does teach an item description is sent from the server to the mobile terminal when a reference is made on the purchase specification. It would be obvious to one skilled in the art at the time of the invention to combine the settlement system of Niwa with the item descriptions of Toyoda. The rationale is that the claimed invention is simply a combination of old elements, and in the combination each element performs the same function as it does separately, and the results of the combination are predictable (rationale A of the *KSR* decision).

Examiner's Note

Examiner has cited sections of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or cited by the Examiner.

Separately regarding rejections under 35 U.S.C. 103 relying upon *KSR* rationale A, in order to overcome these rejections the Examiner recommends that the Applicant provide evidence that satisfy the following sequential two-pronged test:

- 1) the result of the combination is more than the simple linear addition of the elements included in the claim (i.e. the claim is "more than the sum of its parts").
- 2) the additional benefit resulting from the combination would not be obvious to one having ordinary skill in the art at the time of the invention.

Conclusion

See attached PTO-892 *Notice of References Cited* for a list of all prior art made of record which is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leland Marcus whose telephone number is (571)-270-1819. The examiner can normally be reached on 8:30 A.M. - 5:00 P.M. ET, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LRM/

/Mary Cheung/
Primary Examiner, Art Unit 3694